

REMARKS

This document is filed in response to the final office action dated February 3, 2006 ("final Office Action") and the advisory action dated June 20, 2006 ("Advisory Action").

Applicants have amended claim 6 and added new claims 14-40 to particularly point out and distinctly claim the subject matter which they regard as their invention. Support for the above amendments can be found in the specification.¹ Applicants have also amended claims 12 and 13 to correct minor deficiencies. Claims 1-5 were previously cancelled.

Currently, claims 6-40 are pending. Reconsideration of this application, as amended, is respectfully requested.

Applicants would like to take this opportunity to discuss the issues raised in the Advisory Action. The Examiner asserted that Chang (U.S. Patent 4,138,381) discloses a thickener containing a solid content of 56%, which is close to 60% (the lower end of the range of 60-85% recited in claim 6). He therefore concluded that "a skilled artisan would be motivated to increase the solid content of the Chang's composition for reasons cited in the final rejection." See the Advisory Action, page 2, lines 5-6. The final rejection referred to by the Examiner states that "[t]he prior art compositions may have higher amounts of solids in order to reduce the volatile content of the composition or to increase the mechanical performance of the coating resulting from higher filler content." See the final Office Action, page 3, lines 10-12.

As already pointed out in the response to the final Office Action, Chang teaches paint compositions with desirable properties, i.e., good flow and good sag resistance. Nowhere in this reference is it suggested increasing the solid content to reduce the volatile content of the compositions or improve the mechanical performance, as indicated by the Examiner. Indeed, increasing the solid content would sacrifice the desired properties of Chang's paint compositions,

¹ Support for the amendment to claim 6 appears at page 12, lines 5-9. Support for new claims 14 and 15 appears at Page 19, lines 11-12; and Page 21, lines 26-30, respectively. Support for new claim 16 can be found Page 12, line 17 through page 12, line 19; and page 21, line 23 through page 22, line 14. Claims 17-23 are based on claims 7-13. Support for new claims 24-40 are based on claims 1-13 and the examples at page 25 through page 28.

i.e., good flow and good sag resistance. As a result, a skilled artisan, in view of Chang, would have been not motivated to increase the solid content of Chang's compositions, as asserted by the Examiner. On the contrary, he would have lowered the solid content, instead of increasing it, in order to obtain better flow and sag resistance properties.

Applicants again would like to bring to the Examiner's attention the judiciary holding in *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984), i.e., "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." As discussed above, Chang does not suggest increasing the solid content of a paint composition. Absent such a suggestion, the mere fact that Chang's compositions could be so modified would have not have made the modification obvious. In other words, claim 6, which requires a high solid content of 60-85%, is not rendered obvious by Chang.

In any event, claim 6 can be distinguished from Chang on a second and independent ground. Claim 6, as amended, requires an emulsion containing a polymer. As stated in the declaration by inventor Takahiro Miwa (enclosed herewith as "Exhibit A"), the polymer used in Chang's compositions (e.g., by the procedure described in example 2) is in the solution form. Chang does not teach or suggest that the polymer be in the emulsion form. Thus, it does not render claim 6 obvious for this additional reason.

For the reasons set forth above, claims 7-15, which all depend from claim 6, are also not rendered obvious by Chang.

We now turn to new claims 16-40. Among them, claim 16, 24, and 32 are independent. Each of these claims recites "an emulsion containing a polymer." As discussed above, Chang does not teach or suggest using a polymer in the emulsion form. Thus, it does not render claims 16, 24, and 32 obvious.

For the same reasons, claims 17-23 (dependent from claim 16), claims 25-31 (dependent from claim 24), and claims 33-40 (dependent from claim 32) are also not rendered obvious over Chang.

Applicants would also like to take this opportunity to discuss the patentability of the pending claims, including new claims 14-40, over the other two references relied on by the Examiner in the final Office Action, i.e., Nonweiler (U.S. Patent 5,610,215) and Shay (U.S.

Patent 5,478,602). The four independent claims, i.e., claims 6, 16, 24, and 32, will be discussed first.

Claims 6 and 16 cover a composition containing a thickener and a water-based copolymer latex. In the composition, the thickener makes up 0.01-2 parts and the copolymer latex makes up 10-60 parts.

Claims 24 and 32 each cover a method for increasing viscosity of a composition for vibration damper. They require that, in the composition, the thickener makes up 0.01-2 parts and the copolymer latex makes up 10-60 parts.

Nonweiler describes an aqueous emulsion-based coating composition containing a thickener, a latex, and a filler. This reference is silent on the ratio of each of the three components to the solid portion in the composition. In the other words, it does not teach or suggest the specific amounts of the thickener and the latex in the composition. Such parameters are required by claims 6, 16, 24, and 32.

Shay does not cure this deficiency. It discloses an associative polymeric thickener prepared from unsaturated carboxylic acid, unsaturated monomer, and hydrophobe-containing macromonomer. It further describes a composition containing a thickener, a latex, and a filler. Like Nonweiler, it is also silent on the specific amounts of the thickener and the latex in the composition. Such parameters are required by claims 6, 16, 24, and 32.

In sum, Nonweiler and Shay, alone or in combination, do not teach or suggest the parameters required by claims 6, 16, 24, and 32. In other words, claims 6, 16, 24, and 32 are patentable over Nonweiler and Shay.

For the reasons set forth above, claims 7-15 (dependent from claim 6), claims 17-23 (dependent from claim 24), claims 26-31 (dependent from claim 24), and claims 33-40 (dependent from claim 32) are also not rendered obvious by Nonweiler and Shay.

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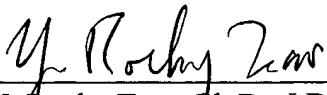
CONCLUSION

Applicants submit that the pending claims all cover subject matter patentable over the cited prior art references. Applicants respectfully request that the Examiner allow these claims.

Enclosed is a \$950 check for excess claim fees and a \$120 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Date: _____

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